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05/031,111	05/22/98	CLARE	SC/C-1-P-4C

L E BARNHART
PATENT AGENT
4330 E 1000 WEST #115
DENVER CO 80067

PM11/0818

EXAMINER
PIKE, A

ART UNIT
3615

PAPER NUMBER

DATE MAILED: 08/18/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/083,422

Applicant(s)
Clare et al.

Examiner
Andrew C. Pike

Group Art Unit
3615



☐ Responsive to communication(s) filed on _____

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-5, 7, 10-12, 14, and 24-33 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-5, 7, 10-12, 14, and 24-33 is/are rejected.

☒ Claim(s) 1-5, 7, 10-12, 14, and 24-33 is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on May 22, 1998 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3615

Oath/Declaration

1. The oath or declaration is defective. A new oath or declaration in compliance with 37 C.F.R. § 1.67(a) identifying this application by application number and filing date is required. See M.P.E.P. §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. § 120, which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 C.F.R. § 1.56 which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

Specifically, it fails to also identify the instant application as being a continuation-in-part of application Serial No. 08/506,893.

2. It is noted that the oath or declaration acknowledges the duty to disclose information which is material to the examination of the application in accordance with 37 C.F.R. § 1.56(a). While this is acceptable, it does not reflect the change in 37 C.F.R. § 1.63(b)(3), effective March 16, 1992, which requires that it:

Acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in § 1.56.

Revision of future oaths or declarations is suggested.

Art Unit: 3615

Claim Rejections - 35 U.S.C. § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. § 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 29 is rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not adequately described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The specification fails to adequately teach how to prefabricate as modules "each" "section" and assemble them together.

5. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-5, 7, 10-12, 14, 24, and 31-33 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Art Unit: 3615

The word "it" in claim 12, line 3, is unclear as to which feature is being referenced. The recitation of "means" in claim 24, line 2, is improper and unclear, since claim 24 lacks a functional recitation of acts which the "means" does; see *Ex parte Klumb*, 159 USPQ 694 (PO Bd. of App. 1967).

The following lack clear antecedent basis: claim 1: line 11, "said fender/side panel" (the terminology "fender/side panel" has not been previously so recited); claim 4: lines 3-4, "said side panel" (singular; which of the "side panels", plural?); claim 10: line 3, "said side panel"; claim 12: line 1, "said side panel"; claim 31: line 3, "said wheel well" (singular; which of the wheel wells, plural?); line 4, "said wheel well"; claim 32: line 2, "said wheel well"; claim 33: line 2, "said wheel well".

Claim Objections

7. Claims 1-5, 7, 10-12, 14, and 24-33 are objected to because of the following informalities:

The phrase "said storage system" should follow the comma in claim 1, line 2. The word "same" in claim 1, line 7, should be replaced by the feature being referenced. There should be a comma after "merchandise" in claim 25, line 1. The word "section" in claim 30, line 3, should be "sections". There

Art Unit: 3615

should be a comma after "rearward" in claim 31, line 3. There should be a comma after "rearward" in claim 31, line 2.

The following are initial recitations which are not so recited, or are subsequent recitations which are not uniquely and/or consistently recited: claim 1: line 2, "the external appearance" (it should be "an external appearance"); line 6, "a side panel" (it should be "one of the side panels"); claim 3: lines 2-3, "the floor" (it should be "a floor"); claim 7: line 2, "storage box" (it should be "said storage box") and "an interior" (it should be "the interior thereof"); line 3, "hinged side panel section" and "latch mechanism".

Appropriate correction is required.

Claim Rejections - Double Patenting

8. Claim 11 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 11 of copending Application No. 08/910,516. Although the conflicting claims are not exactly identical, they are not patentably distinct from each other because of the mere variation of non-patentably distinct features in the claims.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Art Unit: 3615

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 C.F.R. § 3.73(b).

Claim Rejections - 35 U.S.C. § 103

10. The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the Examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary.

Art Unit: 3615

Applicants are advised of the obligation under 37 C.F.R. § 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the Examiner to consider the applicability of 35 U.S.C. § 103(c) and potential 35 U.S.C. §§ 102(f) or (g) prior art under 35 U.S.C. § 103(a).

12. Claims 1-5, 7, 10, 12, and 24 as understood, 25-28, 29 as understood, 30, and 31-33 as understood are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sisler in view of Stiles and Ogilvie, 1966.

Sisler discloses a hidden storage system, for a vehicle having side panels, a driver's side door, a cab, at least one rear door, and an enclosure for equipment having floor, bulkhead, side panel, and tailgate sections, wherein the hidden storage system does not substantially alter the external appearance of the vehicle and comprises a storage box mounted on each side of the enclosure of the vehicle (column 3, lines 36-37) intermediate the doors and extending along a section of the vehicle floor and having at least one compartment, each box covering a wheel well forwardly and rearwardly and having a height less than that of the side panels and being hidden with the external vehicle appearance not being substantially altered; but lacks, for each box, sections of one of the enclosure side panels being hinged for outward movement to open positions, a hidden latch mechanism, lock means, and a strut assembly.

Art Unit: 3615

Stiles discloses a hidden storage system, for a vehicle, comprising a storage compartment mounted on each side of the vehicle (page 2, column 2, lines 8-15), each compartment partially covering a wheel well and wherein a portion 22 of a side panel of the vehicle is hinged to provide access thereto, with the compartment being hidden with the external appearance of the vehicle not being substantially altered.

Ogilvie, 1966, clearly discloses a storage system, for a vehicle having side panels, a driver's side door, a cab, at least one rear door, and an enclosure for equipment having floor, bulkhead, side panel, and tailgate sections, wherein the storage system comprises a storage box mounted on each side of the enclosure of the vehicle intermediate the doors and extending along a floor thereof and covering a wheel well forwardly and rearwardly, and, for each box, sections, including at least one entirely above the wheel well thereof, of a side panel of the vehicle enclosure being hinged for outward movement to open positions, and having a hidden latch mechanism, including hidden latch members, mechanically activated lock means, shelves and compartments, and a strut assembly.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sisler to have, for each box, sections of one of the enclosure side panels being hinged for outward movement to open positions,

Art Unit: 3615

a hidden latch mechanism, lock means, and a strut assembly, as suggested and taught by Stiles and Ogilvie, 1966, because the hinged side panel sections and strut assembly would provide side access to the storage box (Ogilvie, 1966, Fig. 3; Stiles, page 2, column 2, lines 8-15) without substantially altered the appearance of the bed (Sisler, column 1, lines 43-45; Stiles, Fig. 1).

13. Claims 1-3, 5, 7, 12, 14, and 24 as understood, 25-28, 29 as understood, 30, and 31-33 as understood are rejected under 35 U.S.C. § 103(a) as being unpatentable over Sisler in view of Stiles and LeVee.

Sisler discloses a hidden storage system (see paragraph 12 above), but lacks, for each box, sections of one of the enclosure side panels being hinged for outward movement to open positions, a latch mechanism, lock means, and a drain/air relief valve assembly.

Paragraph 12 above is incorporated by reference as to Stiles.

LeVee clearly discloses a storage system, for a vehicle having side panels, a driver's side door, a cab, at least one rear door, and an enclosure for equipment having floor, bulkhead, side panel, and tailgate sections, wherein the storage system comprises a storage box mounted on each side of the enclosure of the vehicle intermediate the doors and extending along a floor

Art Unit: 3615

thereof and covering a wheel well forwardly and rearwardly, and, for each box, sections, including at least one entirely above the wheel well thereof, of a side panel of the vehicle enclosure being hinged for outward movement to open positions, and having a latch mechanism, mechanically activated lock means, shelves and compartments, and drain/air relief valve assembly.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Sisler to have, for each box, sections of one of the enclosure side panels being hinged for outward movement to open positions, a latch mechanism, lock means, and drain/air relief valve assembly, as suggested and taught by Stiles and LeVee, because the hinged side panel sections would provide side access to the storage box (LeVee, Fig. 2; Stiles, page 2, column 2, lines 8-15) without substantially altered the appearance of the bed (Sisler, column 1, lines 43-45; Stiles, Fig. 1), with the drain/air relief valve assembly preventing moisture condensation (LeVee, column 4, lines 15-17).

Specification

14. The specification is objected to under 37 C.F.R. § 1.74 as failing to correctly identify the different parts shown in the figures by unique reference numerals required by 37 C.F.R.

§ 1.84(p)(4):

Art Unit: 3615

Reference numerals 103 and 104 each improperly identifies more than one feature (e.g., 103 on page 16, lines 4 and 6, should be 103' and 104 on page 16, line 6, should be 104', 103 on page 16, line 27, should be 303 and 104 on page 16, line 27, should be 304, etc.). Reference numeral 100' improperly identifies more than one feature. The description of the modification shown in Fig. 12 improperly includes reference numerals of other embodiments. The description of the alternative embodiment shown in Fig. 14 improperly includes reference numerals of a different embodiment. The feature "bed 121" on page 20, lines 17-18, is misidentified. The description of the alternative embodiment shown in Fig. 16 improperly includes reference numerals of a different embodiment.

Appropriate correction is required.

15. The specification is objected to under 37 C.F.R. § 1.74 as failing to correctly identify the views in consecutive Arabic numerals required by 37 C.F.R. § 1.84(u)(1):

The twenty figures shown in the drawings are not identified by the consecutive Arabic numerals 1 through 20.

Appropriate correction is required.

Art Unit: 3615

Drawings

16. The drawings are objected to under 37 C.F.R. § 1.84(h)(3) as failing to correctly show sectional views:

The EPDM or rubber (page 25, line 2) is not shown; the housing 187 is instead shown with a metal cross-sectional hatching. Member 196 lacks cross-sectional hatching in Fig. 19.

Correction is required.

17. The drawings are objected to under 37 C.F.R. § 1.84(p)(4) as failing to uniquely and correctly identify reference numerals:

Reference numerals 103 and 104 each improperly labels more than one feature (e.g., 103 and 104 in Fig. 10 should be 103' and 104', etc.). Reference numeral 100' improperly labels more than one feature. The modification shown in Fig. 12 improperly includes reference numerals of other embodiments. The alternative embodiment shown in Fig. 14 improperly includes reference numerals of a different embodiment. The alternative embodiment shown in Fig. 16 improperly includes reference numerals of a different embodiment.

Correction is required.

18. The drawings are objected to under 37 C.F.R. § 1.84(p)(5) as failing to show reference numerals:

Art Unit: 3615

Feature 80 (page 14, line 1) is not shown labeled.
Feature 106' (page 15, line 26) is not shown labeled. Rod 153
(page 22, line 12) is not shown labeled. Member 208 (page 24,
line 10) is not shown labeled.

Correction is required.

19. The drawings are objected to under 37 C.F.R. § 1.84(u) (1) as failing to correctly consecutively number the views in Arabic numerals:

The twenty figures have not been identified by the consecutive Arabic numerals 1 through 20.

Correction is required.

20. The drawings are objected to under 37 C.F.R. § 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "bulkhead section" (claim 28, line 2); and the claimed subject matter of claim 29, all of lines 1-2, must be shown or the features canceled from the claims. No new matter should be entered.

21. New FORMAL DRAWINGS are required in response to this Office Action. Any proposal for amendment by the Applicants of the drawings to cure defects must include either:

(a) new drawings in compliance with 37 C.F.R. § 1.84, including

(1) a sketch in permanent black ink showing the originally filed drawings with changes thereto in

Art Unit: 3615

red ink in compliance with 37 C.F.R.
§ 1.121(a)(3)(ii), and

(2) new formal drawings correcting the noted defects.

This should be in a *separate* letter, i.e., drawings with a cover letter with an appropriate heading, e.g., "Formal Drawings", in compliance with 37 C.F.R. §§ 1.4(c) and 1.121(a)(3)(ii).

Response to Amendment

22. Receipt of the preliminary amendment filed May 22, 1998, is acknowledged.

Conclusion

23. The prior art made of record and not relied upon is considered pertinent to Applicants' disclosure.

Botella discloses a storage/utility system, for a vehicle, comprising a storage compartment mounted on each side of the vehicle, wherein a portion of a side panel of the vehicle is hinged to provide access thereto, with the compartment being hidden with the appearance of the vehicle not being substantially altered.

Holan et al., Dehnell, Brindle, Ogilvie, 1967, Henri, Fletcher, and Simmacher each discloses a storage/utility system, for a bed of a pickup truck, comprising a storage box mounted on each side of the bed, each box covering a wheel well and having a

Art Unit: 3615

hinged panel providing access thereto and having a lock and latch mechanism.

24. Applicants are hereby notified that the timely period in which to conduct an interview on the merits of the application is *before* final Office action, as it is Office policy to expedite processing of patent applications. Although the Applicants may conduct or set up an interview with the Examiner by telephone at any time during regular Office hours 8:30 a.m. through 5:00 p.m., Monday through Friday, it may be easier to reach the Examiner on Tuesdays and Thursdays, 9:30 a.m. through 2:30 p.m.

Interviews after final Office action are at the Examiner's discretion, M.P.E.P. § 713.09, although they are not precluded thereby. After-final interviews normally will only be granted if the Examiner is convinced that allowance of the application or clarification for appeal may be accomplished with only nominal further consideration. After-final interviews merely to restate arguments of record or to discuss new issues, e.g., limitations which would require further consideration and/or search, will usually be denied.

25. Any inquiry concerning this communication should be directed to Examiner Andrew Pike at telephone number (703) 308-3423.

Correspondence related to this application may be transmitted by facsimile in accordance with 37 C.F.R. § 1.6, except for that correspondence for which facsimile transmission is prohibited under 37 C.F.R. § 1.6(d). Facsimile copies of an original signature under 37 C.F.R. § 1.4(d)(2) on correspondence transmitted by facsimile under 37 C.F.R. § 1.6 are acceptable. Applicants should retain the original correspondence papers as evidence of authenticity. If a question of authenticity arises, the Office may require submission of the original correspondence papers; BUT APPLICANTS SHOULD **NOT** SUBMIT THE ORIGINAL CORRESPONDENCE PAPERS IN ADDITION TO THAT TRANSMITTED BY FACSIMILE unless specifically required to by the Office. The

Serial Number: 09/083,422

Page 16

Art Unit: 3615

Technology Center 3600 Fax Center facsimile number is (703) 305-7687.

Andrew C. Pike
8-14-1998
ANDREW C. PIKE
PRIMARY EXAMINER
ART UNIT 3615

acp
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